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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/039,957 | 12/31/2001 | Sithya S. Khieu | 53325US002 | 8431 |

32692 7590 05/23/2005

3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

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| EXAMINER |
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HARTMANN, GARY S

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| ART UNIT | PAPER NUMBER |
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3671

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,957

Applicant(s)

KHIEU ET AL.

Examiner

Gary Hartmann

Art Unit

3671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9-12,15-17 and 19-29 is/are pending in the application.
4a) Of the above claim(s) 20 and 24-26 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,4-7,9-12,15-17,19,21-23 and 27-29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 31 December 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____



DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6, 7, 9, 12, 15, 17, 21-23 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eigenmann (U.S. Patent 4,072,403).

Eigenmann discloses a marker and method of making pavement markers including forming an array of discrete retroreflective elements (G, Figure 8, for example) in a predefined pattern interconnected by a carrier web (14'). The web is a polymeric material; however, it is not specifically disclosed to be water-soluble or water-dispersible. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used one of these types of polymeric materials as the polymeric material of Eigenmann in order to suit a particular application. Note that since there is no criticality disclosed between the group claimed in the claims filed 9/27/2004 and the group as claimed prior to that amendment, the group as presently claimed is not patentably distinguishable from the group in the claims as originally filed.

The carrier web (14') is bonded to an upper surface of the paving elements (Figure 6, for example).

Regarding claims 6 and 7, see column 2, lines 14-20, for example.

There are retroreflective lenses (18) on the top and side surfaces.

Art Unit: 3671

Given Eigenmann's disclosure that the web is designed to be severed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used slits around a perimeter of the elements in order to separate the elements.

Regarding claim 23, it is well known to use cube corner retroreflective elements in pavement markers and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have done so with Eigenmann in order to obtain a desired visibility characteristic.

There is a frangible connection between a plurality of the pavement elements and the carrier web (Figure 7, for example).

Claims 5, 10, 11, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eigenmann as applied above, and further in view of Clark et al. (U.S. Patent 5,853,846). Eigenmann is silent with respect to an adhesive; however, the markers are designed to be adhered to a roadway and it is well known to use pressure sensitive adhesives to apply markers to roadways. For example, Clark et al. teach a pressure sensitive adhesive (8) with a liner (10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the adhesive of Clark et al. with the marker of Eigenmann in order to obtain a secure connection between the marker and the pavement.

Response to Arguments

Applicant's arguments filed May 3, 2005 have been fully considered but they are not persuasive. Eigenmann describes 14', the element which has been considered to meet the recitation of "carrier web," to be a "thin breakable portions" (column 4, line 46). There is

Art Unit: 3671

nothing recited in the claims that these portions do not meet. Simply, the differences between the present invention and the prior art are not claimed in a manner that patentably distinguishes one from another.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

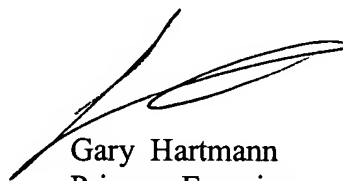
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Hartmann whose telephone number is 571-272-6989. The examiner can normally be reached on Monday through Thursday, 9am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571-272-6998. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3671

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary Hartmann
Primary Examiner
Art Unit 3671

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